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INCORPORATED

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN JOSE DIVISION

In re *Ex Parte* Application of:

Case No. 24-mc-80019

QUALCOMM INCORPORATED,
Applicant.

**EX PARTE APPLICATION FOR AN
ORDER PURSUANT TO 28 U.S.C. §
1782 GRANTING LEAVE TO
CONDUCT DISCOVERY FOR USE IN
A FOREIGN PROCEEDING**

Application for an Order Pursuant to 28
U.S.C. § 1782 Granting Leave to Conduct
Discovery for Use in a Foreign Proceeding

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STATUTES

28 U.S.C. § 1782	1
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Pursuant to 28 U.S.C. § 1782, Qualcomm Incorporated (“Applicant” or “Qualcomm”) respectfully submits this Application to obtain an order permitting it to issue subpoenas to Samsung Semiconductor, Inc. and/or Samsung Electronics America, Inc. (“Samsung”) and Apple Inc. (“Apple”) (collectively, “Respondents”) for use in ongoing foreign legal proceedings pending in the United Kingdom, styled *Consumers’ Association v. Qualcomm Incorporated*, Case No. 1382/7/7/21 (“U.K. Class Action”). Attached hereto are a proposed Order and proposed forms of subpoenas *duces tecum* (Exhibits A and B, for Apple and Samsung respectively). Filed herewith is the supporting Declaration of Helen Fairhead (“Fairhead Decl.”).¹

I. INTRODUCTION

The Consumers’ Association (who represent the class in the U.K. Class Action) has filed a related § 1782 application in this Court in Case No. 23-mc-80322 to obtain discovery from Respondents for use in the U.K. Class Action. Judge Davila granted that application on January 23, 2024. Order, Dkt. No. 21, 5:23-mc-80322-EJD (N.D. Cal. Jan. 23, 2024).

On February 18, 2021, the Consumers’ Association filed a collective proceedings claim form before the Competition Appeal Tribunal (“CAT”)² in the United Kingdom. Fairhead Decl. ¶ 4. The U.K. Class Action involves the Consumers’ Association’s claims that Qualcomm’s chipset supply and licensing practices allowed it to obtain “supra-competitive” royalty payments from Apple and Samsung for its LTE standard essential patents (“SEPs”), and that these “supra-competitive” royalty payments were then passed on to consumers. Fairhead Decl. ¶ 5.

In its § 1782 application, the Consumers’ Association seeks certain documents from Respondents that it believes to be favorable to its own claims in the U.K. Class Action to the exclusion of documents that would be unfavorable to its case. As further described below, these include documents that refute the Consumers’ Association’s arguments and confirm that Qualcomm did not force Apple or Samsung to pay “supra-competitive” royalties for its patents,

¹ Upon service of the proposed subpoenas, Respondents will be able to assert any objections that may be available to them under Federal Rule of Civil Procedure 45, and thus their rights will be fully protected.

² The CAT is a judicial body of the United Kingdom that was created to adjudicate cases involving competition or economic regulatory issues. Fairhead Decl. ¶ 4. A claim for collective proceedings is similar to a class action in the United States.

1 and its licenses with Apple and Samsung were freely negotiated. Qualcomm submits this § 1782
 2 Application seeking its own discovery from Apple and Samsung in response to the Consumers'
 3 Association subpoenas to ensure a level playing field in the U.K. proceedings.

4 As set forth below, Qualcomm's present Application meets the statutory requirements of
 5 Section 1782, and the *Intel* factors weigh in favor of granting the Application. Qualcomm also
 6 intends to file, either concurrently herewith or shortly thereafter, an Administrative Motion to
 7 consider whether the two cases should be related under Civil Local Rules 3-12 and 7-11.

8 **II. RELEVANT BACKGROUND**

9 On December 7, 2023, the Consumers' Association filed an application to obtain discovery
 10 from Apple and Samsung pursuant to 28 U.S.C. § 1782 for use in the U.K. Class Action, which
 11 was granted by Judge Davila on January 23, 2024. Order, Dkt. No. 21, 5:23-mc-80322-EJD (N.D.
 12 Cal. Jan. 23, 2024). The Consumers' Association first acknowledged to Qualcomm and to the CAT
 13 in June 2023 that it may need to file such § 1782 applications in the United States, but it waited
 14 until December 7, 2023 to do so. Fairhead Decl. ¶ 5. Indeed, since January 2023, Qualcomm has
 15 been repeatedly requesting that the Consumers' Association provide details of the third-party
 16 discovery it intended to seek, but the Consumers' Association waited until just before filing its §
 17 1782 application in this Court before finally providing Qualcomm with an indication of the nature
 18 of the discovery it intended to seek from Apple and Samsung. *Id.*

19 The CAT held a fourth Case Management Conference ("CMC") in the U.K. Class Action
 20 on January 9 and 10, 2024. Commenting on the U.S. discovery issue, the CAT noted that the
 21 material requested by the Consumers' Association "may not be of central relevance" but went on
 22 to explain that "there is no suggestion that we go into the trial at this point deliberately on a date
 23 which is before you expect to get the US material."³ Fairhead Decl. ¶ 6.

24 In light of Consumers' Association's application being granted and the fact that the
 25 discovery it seeks is only favorable to its own claims as set forth above, it is Qualcomm's position
 26 that Qualcomm will be unfairly prejudiced unless it is able to obtain discovery that presents a fuller

27
 28 ³ The transcript of the fourth CMC will be made available in due course on the case page of the CAT's
 website. Fairhead Decl. ¶ 6 n. 2.

1 and complete evidentiary picture.

2 **III. INFORMATION REQUESTED FROM RESPONDENTS**

3 The subpoenas that the Consumers' Association will issue on Apple and Samsung are, on
 4 their face, deliberately drafted to exclude any material that may be unhelpful to its position in the
 5 U.K. Class Action. For example, in respect of both Apple and Samsung, the Consumers'
 6 Association seeks documents that "address or evidence the extent to which [they] were or
 7 considered [themselves] to be reliant on Qualcomm for the supply of Chipsets at that time." See
 8 Apple and Samsung Subpoenas, Dkt. Nos. 1-1 and 1-2, 5:23-mc-80322-EJD (N.D. Cal. Dec. 7,
 9 2023). However, there is no reciprocal request for either Apple or Samsung to disclose any
 10 documents that show (a) the extent to which Respondents were *not* reliant on Qualcomm; and (b)
 11 the extent to which Respondents actually relied on alternative sources during the relevant period,
 12 including both self-supply and MediaTek in the case of Samsung, and Intel in the case of Apple.

13 Qualcomm files this Application to remedy the inequity that would be caused by disclosure
 14 of only a subset of one-sided documents and to obtain documents in support of its own defenses in
 15 the U.K. Class Action. By reference to the above example, the present Application seeks documents
 16 that "address or evidence whether, and the extent to which, *non-Qualcomm* Chipsets" were
 17 available to and/or used by Apple and Samsung. *See Exhibit A, Request 4(c); Exhibit B, Request*
 18 *3(c).*

19 For another example, Qualcomm's proposed subpoena to Apple includes a request for
 20 documents produced by Apple which were cited in Qualcomm's opening presentation at the April
 21 2019 trial in *In re Qualcomm Litigation*, No. 17-cv-108 (S.D. Cal.) ("Apple Action"), an action
 22 commenced by Apple against Qualcomm related to Qualcomm's licensing practices. *See Exhibit*
 23 *A, Request 3.* While Apple moved to claw back some of these documents, their motions were
 24 ultimately unsuccessful. *See In re Qualcomm Litig.*, No. 17-cv-108 (S.D. Cal.), Orders of
 25 Magistrate Judge Dembin and District Judge Curiel, Dkt. Nos. 641 (Oct. 2, 2018) & 746 (Dec. 18,
 26 2018), ordering production of 40 documents. Based on the Apple documents quoted in Qualcomm's
 27 opening presentation in the Apple Action, these documents reflect (i) Apple's strategy and conduct
 28 in relation to Qualcomm and the cellular device industry on relevant matters such as Apple's efforts

1 to devalue SEPs and to create licensing and price leverage through purchasing power and litigation,
 2 and (ii) Apple’s views on the strength of Qualcomm’s patent portfolio of essential and relevant
 3 patents for cellular and wireless standards. These documents also directly contradict the
 4 Consumers’ Association’s claim that Apple lacked bargaining power and confirm that Qualcomm
 5 did not force Apple to pay “supra-competitive” royalties for its LTE patents.

6 In addition to these requests for materials that would give context to the discovery the
 7 Consumers’ Association seeks, Qualcomm’s proposed subpoenas include the same information
 8 from Respondents as requested by the Consumers’ Association in its application, to ensure that
 9 Qualcomm obtains equal access to such information for use in the U.K. Class Action. *See Exhibit*
 10 A, Requests 1, 2, 4(a)-(b), 5, 6; Exhibit B, Requests 1, 2, 3(a)-(b), 4, 5. In this regard, and in respect
 11 of disclosure obtained from Apple and Samsung’s subsidiaries in the U.K., the Tribunal noted at
 12 the most recent CMC that, “I don’t think it would be reasonable for [the Consumers’ Association]
 13 to get documents, sit on them for two months and then have a look at them” for the purposes of
 14 determining whether they are relevant, and whether they should therefore be shared with
 15 Qualcomm. Fairhead Decl. ¶ 7.

16 IV. ARGUMENT

17 A. Legal Standard

18 Pursuant to 28 U.S.C. § 1782, a district court may order the production of documents or
 19 testimony for use in a foreign legal proceeding before a foreign or international tribunal. 28 U.S.C.
 20 § 1782(a). Applications brought under § 1782 are typically considered on an *ex parte* basis because
 21 “parties will be given adequate notice of any discovery taken pursuant to the request and will then
 22 have the opportunity to move to quash the discovery or to participate in it.” *IPCom GmbH & Co.*
 23 *KG v. Apple Inc.*, 61 F. Supp. 3d 919, 922 (N.D. Cal. 2014) (quoting *In re Republic of Ecuador*,
 24 No. C-10-80225 MISC CRB (EMC), 2010 WL 3702427, at *2 (N.D. Cal. Sept. 15, 2010)).

25 To authorize discovery under 28 U.S.C. § 1782, three requirements must be met: (1) the
 26 application must be made by an interested party or upon application of a foreign or international
 27 tribunal; (2) the party from whom discovery is sought must “reside” or be “found” in the
 28 jurisdiction of the district court where the § 1782 petition has been filed; and (3) the document or

1 testimony must be “for use” in a foreign or international tribunal. *Intel Corp. v. Advanced Micro*
 2 *Devices, Inc.*, 542 U.S. 241, 246 (2004).

3 The Supreme Court has also identified four discretionary factors for district courts to
 4 consider when ruling on a § 1782 application: (1) whether the person from whom discovery is
 5 sought is a participant in the foreign proceeding; (2) the nature of the foreign tribunal, the character
 6 of the proceedings underway abroad, and the receptivity of the foreign government, court or agency
 7 to U.S. federal-court judicial assistance; (3) whether the § 1782 request conceals an attempt to
 8 circumvent foreign proof-gathering restrictions or other policies of a foreign country or the United
 9 States; and (4) whether discovery would be unduly intrusive or burdensome. *Intel*, 542 U.S. at 264–
 10 65.

11 Here, the statutory requirements are satisfied, and all four *Intel* factors weigh in favor of
 12 granting the Application.

13 **B. The Requirements of § 1782 Are Satisfied**

14 First, Qualcomm is an “interested party” in the U.K. Class Action because it is a party to
 15 these foreign proceedings. Fairhead Decl. ¶ 8; *see also Intel*, 542 U.S. at 256; *In re Ex Parte*
 16 *Application of Varian Med. Sys. Int'l AG, Applicant*, No. 16-mc-80048-MEF, 2016 WL 1161568,
 17 at *3 (N.D. Cal. Mar. 24, 2016) (“Varian qualifies as an ‘interested person’ because it is a
 18 participant in the foreign proceeding.”).

19 Second, Respondents can be “found” in this district. Specifically, Apple’s headquarters are
 20 located in this district at One Apple Park Way, Cupertino, California 95014. Fairhead Decl. ¶ 9.
 21 Samsung Semiconductor, Inc. maintains its “campus” office in this district at 3655 N 1st Street,
 22 San Jose, California 95134. *Id.*; *see In re Varian Med. Sys.*, 2016 WL 1161568, at *3 (finding that
 23 this requirement was satisfied where target of the subpoena was “located...within the Court’s
 24 jurisdiction in the Northern District of California”); *In re Ex Parte Application of Qualcomm Inc.*,
 25 162 F. Supp. 3d 1029, 1036 (N.D. Cal. 2016) (subpoena targets were “found” in the district because
 26 they maintained offices in the district). Samsung Electronics America, Inc., although domiciled in
 27 New Jersey, is registered to conduct business in California, “conduct[s] systematic and continuous
 28 local activities in this district,” and has “availed [itself] of the jurisdiction of this court in many

1 protracted lawsuits.” *In re Ex Parte Application of Qualcomm Inc.*, 162 F. Supp. 3d at 1036. Indeed,
 2 in granting the Consumers’ Association’s application, this Court determined that both Samsung
 3 entities are “found” in this District for the purposes of § 1782. *See Order of District Judge Davila,*
 4 Dkt. No. 21 at 4, 5:23-mc-80322-EJD (Jan. 23, 2024); *see also In re Ex Parte Application of*
 5 *Qualcomm Inc.*, 162 F. Supp. 3d at 1036 (finding that the “combined effect of all these activities

6 and contacts adds up to systematic and continuous local activities in this district” so that this
 7 requirement of § 1782 is satisfied in respect of Samsung Electronics America, Inc.).

8 Third, the information requested from Respondents is “for use” in the U.K. Class Action.
 9 Specifically, it will be used to further support Qualcomm’s arguments in these foreign proceedings
 10 that it did not force Apple or Samsung to pay “supra-competitive” royalties for its patents, and its
 11 licenses with Apple and Samsung were freely negotiated. Fairhead Decl. ¶ 10; *see Order of District*
 12 *Judge Davila*, Dkt. No 21 at 6-7; *In re Varian Med. Sys.*, 2016 WL 1161568, at *3 (finding that this
 13 requirement was met where the applicant sought to use the discovery to support its claims in the
 14 pending foreign litigation).

15 C. The *Intel* Factors Weigh in Favor of Granting the Application

16 First, Respondents are not participants in the U.K. Class Action. Fairhead Decl. ¶ 11; *cf.*
 17 *Intel*, 542 U.S. at 264 (“[W]hen the person from whom discovery is sought is a participant in the
 18 foreign proceeding . . . , the need for § 1782(a) aid generally is not as apparent as it ordinarily is
 19 when evidence is sought from a nonparticipant in the matter arising abroad.”).

20 The discovery sought from Respondents is also not obtainable through the foreign
 21 proceedings because, on information and belief, Respondents, and the discovery sought, are located
 22 outside of the jurisdiction of the foreign court. Fairhead Decl. ¶ 12. The CAT does not generally
 23 have jurisdiction to order disclosure from Apple or Samsung, where the evidence sought by
 24 Qualcomm is not located in the U.K., and neither entity is domiciled in the U.K. *Id.*; *see also Order*
 25 *of District Judge Davila*, Dkt. No. 21 at 5 (“Here, Apple and the Samsung Entities are not parties
 26 in the U.K. Class Action and are not domiciled in the U.K., and therefore, the Tribunal would be
 27 unable to compel them to produce discovery without the aid of Section 1782.”); *In re Varian Med.*
 28 *Sys.*, 2016 WL 1161568, at *3 (finding that the “the key issue is whether the material is obtainable

1 through the foreign proceeding") (quoting *In re Judicial Assistance Pursuant to 28 U.S.C. 1782 by*
 2 *Macquarie Bank Ltd. (Macquarie Bank II)*, No. 2:14-cv-00797-GMN-NJK, 2015 WL 3439103, at
 3 *6 (D. Nev. May 28, 2015)). This factor therefore weighs in favor of granting the Application.

4 Second, the CAT has indicated that it is receptive to judicial assistance via § 1782
 5 discovery. Fairhead Decl. ¶ 13. While the CAT has expressed concern with the impact of third-
 6 party disclosure on its schedule, this factor typically weighs against granting an application only
 7 where there is some directive from a foreign tribunal that it would not be receptive to the requested
 8 material. *See, e.g., Schmitz v. Bernstein Liebhard & Lifshitz LLP*, 376 F.3d 79, 84-85 (2d Cir. 2004)
 9 (denying § 1782 discovery where the German government expressly objected to application
 10 because it could adversely affect an ongoing criminal investigation); *In re Varian Med. Sys.*, 2016
 11 WL 1161568, at *4 ("If there is reliable evidence that the foreign tribunal would not make use of
 12 the requested material, it may be irresponsible for the district court to order discovery") (internal
 13 quotations and citations omitted); *In re Ex Parte Appl. of Qualcomm Inc.*, 162 F. Supp. 3d at 1040-
 14 41 (the third *Intel* factor weighed against granting the application where the foreign tribunal stated
 15 that it had no use for the requested discovery). At present, no such directive exists. Fairhead Decl.
 16 ¶ 13; *see also* Order of District Judge Davila, Dkt. No. 21 at 5 (finding that "the second *Intel* weighs
 17 in favor of granting" the Consumers' Association's application).

18 Third, this request is not sought to, and does not have the effect of, circumventing any
 19 foreign proof-gathering limits or other policies of a foreign country or the United States. Fairhead
 20 Decl. ¶ 14; *In re Varian Med. Sys.*, 2016 WL 1161568, at *5 (finding that this factor weighed in
 21 favor of granting the application where the court did not "have any reason to believe that [the]
 22 discovery request is an attempt to undermine the [foreign court] or its policies or proof-gathering
 23 restrictions."). The third *Intel* factor therefore weighs in favor of granting the Application. *See*
 24 Order of District Judge Davila, Dkt. No. 21 at 6.

25 Fourth, the additional discovery sought by Qualcomm is not unduly burdensome or
 26 intrusive. The subpoenas to Apple and Samsung seek categories of information that are clearly
 27 defined and that should be easily identified and produced by Respondents with minimal burden. *In*
 28 *re Varian Med. Sys.*, 2016 WL 1161568, at *5 ("Typically, requests 'become unduly intrusive and

1 burdensome where they are not narrowly tailored, request confidential information and appear to
 2 be a broad ‘fishing expedition’ for irrelevant information.””) (quoting *In re Ex Parte Application*
 3 of *Qualcomm Inc.*, 162 F. Supp. 3d at 1043). Because Respondents will not be unduly burdened by
 4 the request, and any confidentiality concerns can be addressed through a protective order if needed
 5 (in addition to through the existing confidentiality regime under the CAT)⁴, the fourth *Intel* factor
 6 weighs in favor of granting the Application. Fairhead Decl. ¶ 15.

7 **V. CONCLUSION**

8 Because the Application meets the requirements of 28 U.S.C. § 1782, and the *Intel*
 9 discretionary factors weigh in favor of it being granted, Qualcomm respectfully requests that the
 10 Court issue the attached order granting the Application and authorizing the issuance of the
 11 subpoenas *duces tecum* in the form attached to the Application as Exhibit A and Exhibit B.

12 Dated: January 26, 2024

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 27 ⁴ Qualcomm notes that both Apple and Samsung are already familiar with the confidentiality regime in the
 28 U.K. Class Action and have previously consented to certain disclosure of their own material in accordance
 with its terms. Fairhead Decl. ¶ 15 n. 3.